

In re Application of: Eilon Barnea 17
Serial No.: 10/705,459
Filed: November 12, 2003
Office Action Mailing Date: February 23, 2007

Examiner: Dibrino, Marianne NMN
Group Art Unit: 1644
Attorney Docket: 26884

REMARKS

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-71 are in this Application. Claims 1-36, 40-42 and 50-71 were withdrawn from examination under a restriction requirement as drawn to claims involving a non-elected invention. Claims 37-39 and 43-49 have been rejected under 35 U.S.C. § 112 first paragraph. Claim 38-39 and 43-49 have been cancelled herewith. Claim 37 has been amended herewith.

Objections to the drawings

The Examiner has objected to the drawings as failing to comply with 37 CFR 1.84(p) (4) because the incorrect sequence listing number was used. Please find attached a replacement sheet for Figure 5D.

35 U.S.C. § 112, First Paragraph, Rejections

The Examiner has rejected claims 37-39 and 43-49 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

The Examiner states that the specification does not disclose how to make and/or use the peptide of SEQ ID NO: 20, a pharmaceutical composition comprising SEQ ID NO: 20, including wherein SEQ ID NO: 20 is presented in context of an antigen presenting cell. Furthermore, the Examiner states that the specification does not disclose that SEQ ID NO: 20 is immunogenic – i.e. that it is capable at the least of stimulating CTL in vitro or inducing an immune response in vivo. In addition, the Examiner states that the specification does not provide any evidence that a patient's condition may be clinically improved using the peptide of SEQ ID NO: 20 as a vaccine.

In order to expedite prosecution of this case, Claims 38-39 and 43-49 have now been cancelled. Applicant maintains his rights to file a divisional application with the excluded matter.

The peptide of the present invention now claimed is enabled at least for research purposes in general and for cancer research in particular as is evident in the instant application. Firstly, the Applicant has shown that this peptide is derived from a known tumor antigen - MAGE-B2, and has been validated as being MHC bound peptides. Secondly, the

In re Application of: Eilon Barnea
Serial No.: 10/705,459
Filed: November 12, 2003
Office Action Mailing Date: February 23, 2007

18

Examiner: Dibrino, Marianne NMN
Group Art Unit: 1644
Attorney Docket: 26884

Applicant has shown that the peptide was detected only in ovarian cancer cells (UCI-107) and not in other cell lines – see Table 9, page 58 of the instant application.

In view of the above clarifications and claim amendments, Applicants believe to have overcome these 35 U.S.C. § 112, first paragraph rejections.

Double Patenting Rejection

The Examiner has rejected claims 37-39, 43, 48, 49 under the judicially created doctrine of non-statutory obviousness type double patenting.

A terminal disclaimer in compliance with 37 CFR 3.73(b) and which overcomes the Examiner's rejections is enclosed herewith.

The Examiner has rejected claims 37-39, 4-49 as being unpatentable over claims 1-3 of commonly assigned US 6,867,283. Claim 37 has now been amended to limit the peptide to that set forth by SEQ ID NO: 20 thereby canceling peptides that do not belong to non-elected groups. This action renders moot the Examiners rejection in this case.

The Examiner has rejected claims 44-47 as being unpatentable over claims 1-3 of commonly assigned US 6,867,283 in view of WO 96/25434 A1. Claims 44-47 have now been cancelled rendering moot the Examiners rejection in this case.

In view of the above amendments and remarks it is respectfully submitted that claim 37 is now in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,


Martin D. Moynihan
Registration No. 40,338

Date: July 6, 2007

Encl:

Change of Address
Petition for Extension for Two Months Time
Terminal Disclaimer
Letter to Chief Draftsman
Annotated Marked Up Figures (1 Sheet)
Formal Drawings Transmittal Sheet
Replacement Drawings (5 Sheets)